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In re Application of
WYATT et al : DECISION ON
Application No.: 09/446,799 :
PCT No.: PCT/US98/23998 : PETITION
Int. Filing Date: 10 November 1998 :
Priority Date: 10 November 1997 : UNDER 37 CFR 1.47(a)
Attorney's Docket No.: 157/48457 :
For: GLYCOSYLATED MODIFIED PRIMATE
LENTIVIRUS ENVELOPE POLYPEPTIDES :
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This is in response to the petition under 37 CFR 1.47(a), filed 09 September 2000, to permit the signing joint inventors to file the above-captioned application on their own behalf and on behalf of the non-signing joint inventors.

On 22 December 1999, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a petition and fee to revive the international application. In a decision mailed 10 April 2000, applicants' petition to revive was granted.

On 18 April 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an executed oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set a one-month time limit in which to respond.

On 09 September 2000, applicant submitted the following:

1) a petition under 37 CFR 1.47(a);

2) a declaration executed by Richard T. Wyatt and Joseph G. Sodroski on their behalf and on the behalf of the non-signing inventors, Peter D. Kwong and Wayne A. Hendrickson;

3) a petition fee;

4) letters signed by Ronald I. Eisenstein seeking Dr. Weinberger assistant in obtaining the signatures of the Peter Kwong and Wayne Hendrickson on the declaration and the assignment;

5) a petition and fee for a five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants' petition satisfies items (1), (3) and (4) above.

Regarding item (2) above, no evidence has been presented that a complete set of application papers were presented to Peter Kwong and Wayne Hendrickson. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. The letters sent to applicant only indicate that a declaration, small entity and assignment documents were sent to applicants. Copies of documentary evidence such as a certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that a complete copy of the application papers had been sent to the applicant should be made a part of the declaration or affidavit.

Furthermore, there is not a first-hand statement from the person who tried to contact Peter Kwong and Wayne Hendrickson. In the present instance, the materials were mailed to Dr. Weinberger at Columbia University asking her to obtain Mr. Kwong's and Mr. Hendrickson's signatures on the documents. There is no evidence submitted that Dr. Weinberger gave these materials to the inventors. Nancy Grodin, Licensing Associate, Office of Technology, Dana-Farber Cancer Institute has filed a statement stating, "In September 2000, I was advised by Dr. Weinberger that while Columbia University would execute a Small Entity document, it would not at this time have the Declarations executed. She stated that as they had other applications pending which applications involving some of the same inventors from both Dana-Farber Cancer Institute and Columbia University, the would not have the Declarations executed until advised by their attorneys that all issues of any possible overlapping subject matter had been resolved." Ms. Grodin statement was dated September 12, 2000. Accordingly, it is not clear whether Columbia University at the time of Ms. Grodin statement that the attorneys for Columbia University had come to final determination that the inventors should not sign the declaration. Ms. Grodin did not submit a copy of correspondence from Dr. Weinberger nor did she state that Dr. Weinberger communicated with her by some other means. Where there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is

an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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